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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,891	11/28/2001	Masakazu Nishikawa	Q66604	8056

7590 03/31/2003

SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, NW  
Washington, DC 20037-3213

EXAMINER

KAPADIA, VARSHA A

ART UNIT	PAPER NUMBER
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2651

DATE MAILED: 03/31/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/994,891	<b>Applicant(s)</b> NISHIKAWA ET AL.	
	<b>Examiner</b> Varsha A Kapadia	<b>Art Unit</b> 2651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2651

### **Priority Papers**

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### **Information Disclosure**

The information disclosure statement (IDS) submitted on November 28, 2001 has been received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### **Rejection Under 35 U.S.C. 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Nagao et al. (6,433,944).

Art Unit: 2651

With regards to claim 1, Nagao et al discloses a magnetic transferring method comprising the steps of: bringing a master medium and the slave medium into close contact with each other...; applying a transfer magnetic field; and performing magnetic transfer; wherein the magnetic transfer is performed by bringing a master medium and the slave medium into close contact before formation of the lubricating layer (see col.6 lines 39-44, col.8 lines 10-43, col.11 lines 45 to col.12 lines 31; Example 1-1 on col.15 and Example 4-1 on col.18).

With regards to claims 2-5, Nagao et al discloses a magnetic transferring method comprising the steps of: bringing a master medium and the slave medium into close contact with each other...; applying a transfer magnetic field; and performing magnetic transfer; wherein a recording plane of the slave medium and the information bearing plane of the master medium are brought into close contact through liquid (see col. 13 lines 24-27, col.8 lines 29-32, col.12 lines 9-13 and 29-32 and Examples 1-1 and 4-1 respectively (wherein lubricant is considered as liquid having lubricity)).

With regards to claim 6, Nagao et al discloses the invention as described above in this office action. Furthermore, releasing the closed contact and moving the medium after transferring the information is considered inherent function of the magnetic transferring method.

### **Rejection Under 35 U.S.C. 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada et al (6,469,848) in view of Elliott et al (5,669,979).

With regards to claims 7-8 Hamada et al discloses method/apparatus for cleaning a magnetic transfer master medium, used in a magnetic transferring method as claimed (see col.11 lines 4-12). Hamada et al fails to specify steps/means for burning and removing an article stuck to a surface of the master medium by using a plasma discharge under an atmosphere of pressure reduced reactive gas.

However, such a medium cleaning method/apparatus is disclosed by Elliott et al (see col.12 lines 48 to col. 13 line 3 and col.17 lines 12-16, col.1 lines 35-40 and col.3 lines 56-58).

It would have been obvious to one of ordinary skilled in the are at the time the invention was made to modify the master medium of Hamada et al with the above cleaning method/apparatus from Elliott et al in order to burn/remove the dust particle from the medium and hence to increase the reliability, as taught by Elliott et al.

#### **Prior Art Cited**

Reference to Ishida et al (6,347,016) cited as of interest.

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Varsha A Kapadia whose telephone number is (703) 305-4198. The examiner can normally be reached on Mon-Fri from 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Hudspeth can be reached on (703) 308-4825. The fax phone numbers for

Art Unit: 2651

the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 746-7423 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



VK  
March 23, 2003



DAVID HUDSPETH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600